IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: LANCE W. RUSSELL	Art Unit	: 2143
Serial No.	: 09/895,235	Examiner	: Bilgrami, Asghar H.
Filed	: June 28, 2001	Confirmation No.:	8674
Title	: MIGRATING RECOVERY MODULES IN A DISTRIBUTED COMPUTING ENVIRONMENT		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 CFR 1.181

I. Introduction

Applicant hereby petitions the Director to set aside the Office action dated September 18, 2008, (hereinafter referred to as the "pending Office action") and reinstate the Appeal that was pending at the time the pending Office action was mailed.

II. The Pending Office action Should be Withdrawn and the Appeal Should be Reinstated

A. The rules do not permit the Examiner to reopen prosecution at the present stage

Under MPEP § 1207.04, "The examiner may, with approval from the supervisory patent examiner, reopen prosecution to enter a new ground of rejection after appellant's brief or reply brief has been filed." In the instant case, however, the Examiner did not reopen prosecution to enter a new ground of rejection after the Appeal Brief was filed on June 17, 2008.

MPEP § 1207.03.III explains that:

> There is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). Where the statutory basis for the rejection remains the same, and the

CERTIFICATE OF TRANSMISSION

I hereby certify that this document is being transmitted to the Patent and Trademark Office via electronic filing on the date shown below.

Nov. 18, 2008
Date of Transmission

/Edouard Garcia, Reg. No. 38, 461/
(Signature of person mailing papers)

Edouard Garcia
(Typed or printed name of person mailing papers)

> evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection. *Id.* at 1303, 190 USPQ at 427 (reliance upon fewer references in affirming a rejection under 35 U.S.C. 103does not constitute a new ground of rejection).

In the appeal that was initiated by the Notice of Appeal and the Appeal Brief that were filed on June 17, 2008, the claims were rejected as follows:

A. Claim 5 was rejected under 35 U.S.C § 112, first paragraph.

B. Claim 5 was rejected under 35 U.S.C § 102(e) over Turek (U.S. 6,460,070).

C. Claim 5 was rejected under 35 U.S.C § 103(a) over Turek (U.S. 6,460,070) in view of Harvell (U.S. 6,834,302).

D. Claims 1-4, 6-9, 21-25, and 30 were rejected under 35 U.S.C § 103(a) over Turek (U.S. 6,460,070) in view of Sreenivasan (U.S. 2002/0049845).

E. Claims 27-29 were rejected under 35 U.S.C. § 103(a) over Turek (U.S. 6,460,070) in view of Douik (U.S. 6,012,152).

In the pending Office action dated September 18, 2008, the claims were rejected as follows:

A. Claim 5 was rejected under 35 U.S.C § 103(a) over Turek in view of Sreenivasan.

B. Claim 15 was rejected under 35 U.S.C § 103(a) over Turek in view of Sreenivasan.

C. Claims 1-4, 6-9, 21-25, and 30 were rejected under 35 U.S.C § 102(e) over Turek.

D. Claims 27-29 were rejected under 35 U.S.C. § 103(a) over Turek in view of Douik.

Thus, the only differences between the claim rejections in the pending Office action and the claim rejections that were the subject of the preceding appeal are as follows:

1. Claim 5 now is rejected under 35 U.S.C § 103(a) over Turek in view of Sreenivasan instead of under 35 U.S.C. § 112, first paragraph, under 35

U.S.C § 102(e) over Turek, and under 35 U.S.C § 103(a) over Turek in view of Harvell.

2. Claims 1-4, 6-9, 21-25, and 30 now are rejected under 35 U.S.C § 102(e) over Turek instead of under Turek in view of Sreenivasan.

The first difference between the claim rejections of the pending Office action and the preceding appeal does not constitute a new ground of rejection because the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection (see MPEP § 1207.03.III). Indeed, the Examiner purportedly has relied on the disclosure of Sreenivasan solely to support the rejection in a minor capacity (i.e., to make-up for the lack of specific disclosure of "agent using a 'heartbeat messaging protocol'"; see § 3 on page 2 of the pending Office action). In addition, in the Appeal Brief dated June 17, 2008, Applicant already has addressed the differences between subject matter similar to that claimed in claim 5 and a similar combination of the disclosures of Turek and Sreenivasan (see, e.g., pages 30-32 of the Appeal Brief dated June 17, 2008). Therefore, the first difference between the claim rejections does not constitute a new ground of rejection.

The second difference between the claim rejections of the pending Office action and the preceding appeal does not constitute a new ground of rejection because reliance upon fewer references in affirming a rejection under 35 U.S.C. 103 does not constitute a new ground of rejection (See *In re Kronig*, 539 F.2d 1300, 1303, 190 USPQ 427 (CCPA 1976); see MPEP § 1207.03.III). Even though the statutory ground of rejection has been changed from § 103(a) to § 102(e), such a change merely is a technicality that arises from the fact that the number of references has changed from two to one rather than one that changes the basic thrust of the rejection. In addition, the second difference between the claim rejections of the pending Office action and the preceding appeal does not constitute a new ground of rejection because the basic thrust of the rejection remains the same such that the Applicant would have been given a fair opportunity to react to the rejection had it been presented in an Examiner's Answer (see MPEP § 1207.03.III). Indeed, despite the change in statutory basis, the arguments presented in the Appeal Brief already address substantially the same issues that are implicated in the rejection of claims 1-4, 6-9, 21-25, and 30 under 35 U.S.C. § 102(e) in the pending Office action. For example, in the Appeal Brief dated June 17, 2008, Applicant already has explained the

differences between the claimed invention and Turek's disclosure (see, e.g., pages 25-32 of the Appeal Brief dated June 17, 2008). Therefore, the second difference between the claim rejections does not constitute a new ground of rejection.

Thus, none of the differences between the grounds of rejection in the pending Office action and the grounds of rejection in the preceding Appeal constitutes a new ground of rejection. Therefore, the Examiner is not permitted to reopen prosecution under the rules. Instead, the Examiner should have included the minor changes to his grounds of rejection in an Answer to Applicant's Appeal Brief (see MPEP § 1207.03).

For at least these reasons, the Director is asked to set aside the Office action dated September 18, 2008, and reinstate the Appeal that was pending at the time the pending Office action was mailed.

C. The reopening of prosecution at the present stage contravenes the policy of compact prosecution

The U.S Patent and Trademark Office has articulated a policy of "compact" prosecution that imposes specific obligations on Examiners. Among these obligations is the requirement "that both examiners and applicants provide the information necessary to raise and resolve the issues related to patentability expeditiously" (Official Gazette dated November 7, 2003).

In the instant case, the reopening of prosecution at the present stage contravenes the Office's policy of compact prosecution. In particular, as explained above the pending Office action does not introduce any new grounds of rejection. Instead, the pending Office action only makes minor changes to the technical grounds of rejection of some of the claims without changing the basic thrust of the rejections and without changing the prior art disclosures that were relied upon in support of the grounds of rejection in the preceding Appeal. These minor changes readily could have been included in an Examiner's Answer to the pending Appeal Brief without requiring any additional delay in the resolution of the issues related to patentability.

In addition, the pending Office action does not contain any response to the arguments that were raised in the Appeal Brief dated June 17, 2008, arguments which apply directly to all of the grounds of rejection in the pending Office action. Instead, the Examiner merely stated perfunctorily that "Applicant's arguments ... have been considered but are moot in view of the

new ground(s) of rejection" (see §§ 20, 21 on page 8 of the pending Office action). Such a lack of response constitutes a failure to expeditiously provide a basis for resolving patentability issues, prevents Applicant from presenting appropriate patentability arguments or rebuttal evidence, and needlessly encourages piecemeal prosecution.

For at least this additional reason, the Director is asked to set aside the Office action dated September 18, 2008, and reinstate the Appeal that was pending at the time the pending Office action was mailed.

D. The reopening of prosecution at the present stage thwarts Applicant's right to an Appeal

Under 35 U.S.C. § 134, applicants have the right to appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences (see 35 U.S.C. § 134(a). By reopening prosecution at the present stage, the Examiner has unduly interfered with this right without any countervailing benefit. In particular, the reopening of prosecution by the pending Office action prevents Applicant from reaching a just resolution of the differences of opinion between himself and the Examiner regarding the patentability of the pending claims. At the same time, the pending Office action does not provide any basis for moving the parties to a resolution of those differences. Indeed, as explained above the pending Office action does not introduce any new grounds of rejection. In addition, the pending Office action does not contain any response to the arguments that were raised in the Appeal Brief dated June 17, 2008, arguments which apply directly to all of the grounds of rejection in the pending Office action. Instead, the Examiner merely stated perfunctorily that "Applicant's arguments ... have been considered but are moot in view of the new ground(s) of rejection" (see §§ 20, 21 on page 8 of the pending Office action).

For at least this additional reason, the Director is asked to set aside the Office action dated September 18, 2008, and reinstate the Appeal that was pending at the time the pending Office action was mailed.

It is noted that the improper reopening of prosecution under Appeal is part of a consistent pattern of conduct by the Examiner that effectively denies the Applicant the right to have a just resolution of his differences of opinion with the Examiner regarding the patentability of the

claimed subject matter. In particular, the instant application was filed seven and a half years ago. Since that time, the Examiner has issued nine Office actions and the Applicant has filed three appeal briefs in the application. The Examiner has reopened prosecution after each Appeal Brief was filed. In addition, none of the pending claims has been amended since the Amendment dated November 27, 2006. Since that time, the Examiner has mailed four Office actions and the Applicant has filed two appeal briefs in the application. In each of these four Office actions, the Examiner has based his rejections of the claims on the same three references (i.e., Tuerk, Sreenivasan, and Douik), and the basic thrust of the Examiner's position with regard to the patentability of the pending claims has not changed since the nonfinal Office action dated February 8, 2008. Yet, time and again the Examiner has prevented the application from reaching the Board for a just decision regarding the patentability of the pending claims.

III. Conclusion

For at least the reasons explained above, Applicant requests that the Director set aside the pending Office action dated September 18, 2008, and reinstate the Appeal that was pending at the time the pending Office action was mailed.

Charge any excess fees or apply any credits to Deposit Account No. 08-2025.

Respectfully submitted,

Date: November 18, 2008

/Edouard Garcia, Reg. No. 38,461/
Edouard Garcia
Reg. No. 38,461
Telephone No.: (650) 965-8342

Please direct all correspondence to:

Hewlett-Packard Company
Intellectual Property Administration
Legal Department, M/S 35
P.O. Box 272400
Fort Collins, CO 80528-9599